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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,821	10/31/2003	Orrin Shively	54317-024501	1289

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EXAMINER

MILLER, BENA B

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,821

Applicant(s)

SHIVELY ET AL.

Examiner

Bena Miller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/25/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Bena B. Miller

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 01/25/05 has references that were cited by the examiner in the previous action and are therefore not repeated therein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-6, 8 and 9 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear whether the control key recited in line 4 the same as the one of the control keys in line 3.

Regarding claim 4, it is not clear if the outline shape recited in line 6 the same as the outline shape recited in line 8.

Regarding claim 5, the claim is indefinite because the claim recites an improper Markush grouping. The phrase "selected from the group comprising" should read "selected from the group consisting of".

Regarding claim 8, it is not clear if the control key recited is one of the control keys recited in claims 1 and 4.

Regarding claim 9, it is not clear if the several control keys are the same as the plurality of control keys or the at least one control key recited in claims 1, 2 and 4.

Claim 6 contains the trademark/trade name Disney®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the Applicant's remark, the trademark is not considered as a limitation; therefore, is not clear of the purpose of why the trademark is in the claim since it is not used to further structurally define the claim. Further it is not clear if the limitations of the further define the trademark. Further, the claim requires a first, second and third element that represents the head and ears of the cartoon character; however, it appears from the disclosed figures that the control keys forms an outline of the cartoon character. Therefore, it is not clear if the control keys as claimed in claims 1-4 are the same as the circular elements or if the first, second and third elements are additional elements used to outline the cartoon character (Note: If the first, second and third elements are not considered to be the control keys, then the first, second and third elements would appear to be raise the issue of New Matter). Note: Applicant's attention is directed below to the Response to Arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 7-9 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Miyai.

Regarding the claims, Miyai teaches in the figures teaches a consumer electronics device comprising a housing (fig.1), a control panel (fig. 1 and 2), a plurality of control keys (fig. 1 and 2), at one of the control keys and the surround of at least one of the control keys having a outline shape that of a predetermined cartoon character (fig.1 and 2), controls means (fig. 1 and 2) and a tape recorder (fig. 1 and 2). It should be noted that the Examiner considers the ornamental design of the cassette player to be a predetermined cartoon character.

Claims 1, 2, 4, 1/7, 8 and 9 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Appel et al (US Design Patent D266,442).

The device of Appel reads on the structural limitations of the claims including a housing, a control panel, and a plurality of control keys all shown in figure 1. The

Examiner takes the position that the control keys of Appel et al outline a shape of a predetermined cartoon character.

Claims 1, 2, 4, 1/5, 1/6, 1/7, 8 and 9 rejected under 35 U.S.C. 102(e) as being anticipated by Aisenberg (US Design Patent D481,768).

The device of Aisenberg reads on the structural limitations of the claims including a housing, a control panel, a plurality of control keys and a telephone all shown in figure 1 in both of the prior art. The Examiner takes the position that the control keys of the Aisenberg outline a shape of a predetermined cartoon character. Also, the Examiner takes the position that the device of Aisenberg teaches the structural features of claim 6.

Response to Arguments

Applicant's arguments filed 12/01/04 have been fully considered but they are not persuasive. In reference to Applicant's remarks that the trademark Disney® in claim 6 is not a limitation; the Examiner points Applicant's attention to section MPEP 2173.05(u), noted by Applicant in the remarks, that

If a trademark or trade name appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed. Does its presence in the claim cause confusion as to the scope of the claim? If so, the claim should be rejected under 35 U.S.C. 112, second paragraph.

Therefore, the rejection under 35 USC 112, 2nd stands.

In reference to Applicant's remarks that the Examiner is requested to show the Applicant where the prior art teaches or discloses the claimed features, the Examiner

has pointed out the features shown in the prior art and can be clearly seen in the figures pointed out by the Examiner.

In reference to the remaining remarks by the Applicant, the remarks are moot in view of the rejections noted above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Bena Miller
Primary Examiner
Art Unit 3725

bbm
August 24, 2005